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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/079,873	02/22/2002	Hiromitsu Tanaka	219871US0	7887

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EXAMINER

LE, HOA VAN

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 06/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/079,873	Applicant(s) TANAKA ET AL.	
	Examiner Hoa V. Le	Art Unit 1752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2004.
 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☐ Claim(s) _____ is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☒ Claim(s) 1-36 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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This is in response to Paper received on 24 May 2004.

A. The election of species is narrow to the group of claims 1-20 only. Up on further consideration there are more than one invention as narrowly elected on the record.

B. a. For the group of claims 1-20,

1. claim 1-20 are generic to a plurality of disclosed patentably distinct species comprising many possible amine containing compounds in the art. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for an initiation of a search, even though this requirement is traversed.

2. claim 1-20 are generic to a plurality of disclosed patentably distinct species comprising many possible polymer containing electrolytes and their precursors in the art. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for an initiation of a search, even though this requirement is traversed. Applicants are required to disclose a chemical structure of the polymer electrolyte or its precursor as elected.

3. claim 1-20 are generic to a plurality of disclosed patentably distinct species comprising many possible base compounds in the art. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for an initiation of a search, even though this requirement is traversed.

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- If a base compound and an amine containing compound are broadly enough to read on each other, no patentable value would be given to the claims since they are double inclusion. It is now notified for the record.

b. For the group of claims 21-22,

1. claim 21-22 are generic to a plurality of disclosed patentably distinct species comprising many possible polymers...“having functional group A” in the art. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for an initiation of a search, even though this requirement is traversed. Applicants are required to disclose a chemical structure of group A as elected.

2. claim 21-22 are generic to a plurality of disclosed patentably distinct species comprising many possible agents...“having functional group B...” in the art. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for an initiation of a search, even though this requirement is traversed. Applicants are required to disclose a chemical structure of group B as elected.

3. claim 21-22 are generic to a plurality of disclosed patentably distinct species comprising many possible first intermediate acid groups in the art. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for an initiation of a search, even though this requirement is traversed. Applicants are required to disclose a chemical structure of the acid group as elected.

4. claim 21-22 are generic to a plurality of disclosed patentably distinct species comprising many possible functional group Cs” in the art. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for an initiation of a search, even though this

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requirement is traversed. Applicants are required to disclose a chemical structure of group C as elected.

5. claim 21-22 are generic to a plurality of disclosed patentably distinct species comprising many possible second intermediate acid groups in the art. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for an initiation of a search, even though this requirement is traversed. Applicants are required to disclose a chemical structure of the acid group as elected.

6. claim 21-22 are generic to a plurality of disclosed patentably distinct species comprising many possible functional group Ds in the art. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for an initiation of a search, even though this requirement is traversed. Applicants are required to disclose a chemical structure of group D as elected.

7. claim 21-22 are generic to a plurality of disclosed patentably distinct species comprising many possible functional group Es in the art. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for an initiation of a search, even though this requirement is traversed. Applicants are required to disclose a chemical structure of group E as elected.

c. For the group of claims 23-36,

1. claim 23-36 are generic to a plurality of disclosed patentably distinct species comprising many possible polymers having a side chain in the art. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for an initiation of a search, even though this

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requirement is traversed. Applicants are required to disclose a chemical structure of the side chain as elected.

2. claim 23-36 are generic to a plurality of disclosed patentably distinct species comprising many possible terminal acid groups in the art. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for an initiation of a search, even though this requirement is traversed. Applicants are required to disclose a chemical structure of the acid group as elected.

3. claim 23-36 are generic to a plurality of disclosed patentably distinct species comprising many possible intermediate acid groups and modified groups in the art. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for an initiation of a search, even though this requirement is traversed. Applicants are required to disclose a chemical structure of the acid or modified group as elected.

4. claim 23-36 are generic to a plurality of disclosed patentably distinct species comprising many possible crosslinking groups in the art. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for an initiation of a search, even though this requirement is traversed. Applicants are required to disclose a chemical structure of the crosslinking group as elected.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

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- C. Restriction to one of the following inventions is required under 35 U.S.C. 121:
- I. Claims 1-8, drawn to a polymer modifying process, classified in at least class 585, at least subclass 657. Claims 9-20 will be let to be rejoined with their dependent claims. Should applicants urge or show otherwise, additionally several separate restricting groups will be made for the record as shown or urged.
 - II. Claims 21-22, drawn to another polymer modifying process being patentably different or distinct that that in the invention of Group I above, classified in class 585, at least subclass 736.
 - III. Claims 23-32, drawn to a modified polymer being patentably different or distinct from those in Groups I and II above, classified in class 429, subclass 33. Claims 33-36 will be let to be rejoined with their dependent claims. Should applicants urge or show otherwise, additionally several separate restricting groups will be made for the record as shown or urged.

Additional consideration and search for more than one invention would be burdensome, lacking of focusing and diluting a patentability of many distinct claims for an overly handled many issues, tasks and inventions as one.

The inventions of Groups I and II are all related to the processes but have the patentably different and distinct processing steps and have acquired the separate status and searches in the art and can be supported the separate patents as divided by applicants and have no

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evidence on the record that is not required the separate consideration and search since they are the obvious variants because the prior art being applied to one of them would be sufficient against all inventions, restriction for examination purposes as indicated is proper. Applicant should show or provide an evidence to the contrary. In the absence of convincing evidence, the restriction would not be removed.

Inventions Groups (I and II) and Group III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, a solid polymer electrolyte for use in a fuel cell technology can be made by another and materially different process as those in the conventional or known polymer electrolyte in the art. Applicant should show or provide an evidence to the contrary. In the absence of convincing evidence, the restriction would not be removed.

Because these inventions are distinct for the reasons given above and have acquired the separate status and searches in the art and can be supported the separate patents as divided by applicants and have no evidence of the record that are not required the separate consideration and search since they are the obvious variants because the prior art being applied to one of them would be sufficient against all inventions, restriction for examination purposes as indicated is proper. Applicant should show or provide an evidence to the contrary. In the absence of convincing evidence, the restriction would not be removed.

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D. Applicants are advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

E. A telephone call was made to Jane M. Terry on 21 June 2004 to request an oral election to the above restriction requirement, but did not result in an election being made.

Ms. Terry requests a written Office action since her clients are overseas.

F. Other issues have not been considered until a proper election is made and resolved.

G. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332.

The examiner can normally be reached from 6:30 AM to 4:00 PM on Monday through Thursday and about the same time of most Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark F. Huff can be reached on 571-272-1385

Applicants may file a paper by (1) fax with a central facsimile receiving number 703-872-9306,

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

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may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hoa V. Le
Primary Examiner
Art Unit 1752

HOA VAN LE
PRIMARY EXAMINER



HVL
21 June 2004